REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 27, 2004. In order to advance prosecution of this case, Applicant amends Claims 1, 31, 35, and 36. Applicant respectfully requests reconsideration and favorable action in this case.

Section 102 Rejections

The Office Action rejects Claims 31, 33-34, and 38-41 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,260,155 issued to Dellacona ("*Dellacona*"). Because *Dellacona* does not disclose each and every element in Applicant's claims, Applicant respectfully traverses these rejections.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Whether considered alone or in combination with any other cited references, *Dellacona* does not disclose, either expressly or inherently, each and every element of the claims.

For example, *Dellacona* does not disclose, teach, or suggest "a first network interface card coupled with each of the web server processing cards through the midplane . . . the first network interface card forming at least a portion of the first communication path coupling the web server processing cards with the public network," as recited in Applicant's Claim 31. In the Office Action, the Examiner cites portions of *Dellacona* describing Figure 4 as disclosing a first network interface card coupled with each of the plurality of web server processing cards. (Office Action, page 2). Regarding Figure 4, however, *Dellacona* discloses that a server system 10 is "connected to a fibre channel disk storage device array subsystem 12 . . . [which] utilizes an integrated, fault tolerant and scalable disk storage design, with a plurality of disk storage devices 22, with each disk storage device mounted on a bypass interface card 24 that connects to a unique vertical mid-plane connector board 26." (Column 5, line 58 through Column 6, line 10). "Each mid-plane connector board advantageously has sockets 28

for connecting interface cards for components on each side of the mid-plane connector board, and each mid-plane connector board further can have upper and lower sets of sockets, allowing for components to be mirrored left and right, and top and bottom, to significantly increase fault tolerance of the information server system." (Column 6, lines 11-17). Thus, when a bypass interface card 24 is failing or is being removed, the information server system 10 may switch disk storage components 22 off and on as they are being taken on and off-line. (Column 6, lines 29-37). As such, bypass interface cards 24 merely act to communicate information in disk storage devices 22 to and from server system 10. Accordingly, even if bypass interface cards 24 are considered to correspond with Applicant's network interface card, which Applicant does not admit, and server 10 is considered to correspond with Applicant's web server processing cards, which Applicant also does not admit, *Dellacona* cannot be said to disclose, teach, or suggest "a first network interface card coupled with each of the web server processing cards through the midplane . . . the first network interface card forming at least a portion of the first communication path coupling the web server processing cards with the public network," as recited in Applicant's Claim 31.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Applicant's Claim 31.

Dependent Claims 33-34 and 38-41 depend upon independent Claim 31 and are not anticipated by *Dellacona* at least because they include the limitations of Claim 31, which Applicant has shown above to be allowable. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 33-34 and 38-41.

Section 103 Rejections

The Office Action rejects Claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over *Dellacona* and in view of U.S. Patent No. 5,790,548 issued to Sistanizadeh et al. ("*Sistanizadeh*"). Applicant respectfully traverses these rejections for the reasons stated below.

First, Applicant submits that one of ordinary skill in the art at the time of Applicant's invention would not have been motivated to combine the server information system of *Dellacona* with the corporate LANs of *Sistanizadeh*. Even where an invention is as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the

claim combination. *ASC Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). In the Office Action, the Examiner acknowledges that *Dellacona* fails to disclose web server processing cards coupled with a private network. (Office Action, page 5). The Examiner states, however, that *Dellacona* "suggested exploration of art and/or provided a reason to modify the data processing system with the private network communication router (Figure 2)." (Office Action, page 5). Applicant disagrees with the Examiner's characterization of Figure 2 of *Dellacona*. Figure 2 is merely an illustration of a preferred server configuration for the system disclosed in *Dellacona*. Further, *Dellacona* provides that the server configuration is designed to respond to the need to "eliminate the incomparability problems previously associated with performing diagnostics of an information server system." Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated at the time of Applicant's invention to combine the teachings of *Dellacona* with the teachings of *Sistanizadeh* to "include the private network feature in response to the need for telecommuting (*Sistanizadeh*, column 4 lines 32-43) since users would be able to access their private network from home (*Sistanizadeh*, column 4 lines 32-43)," as the Examiner suggests. To the contrary, the Examiner's speculation at to why "it would have been obvious" to make the proposed combination merely restates the objective of the system disclosed in *Sistanizadeh*. There is no disclosure in either *Dellacona* or *Sistanizadeh*, however, that provides the necessary suggestion or motivation for combining the server information system of *Dellacona* with the corporate LANs of *Sistanizadeh*. Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200 (Fed. Cir. 1991).

Second, Applicant respectfully submits that neither *Dellacona* nor *Sistanizadeh* recite each and every limitation recited in Applicant's claims. For example, Applicant's independent Claim 1 recites "a first network interface card coupled with each of the plurality of web server processing cards and the midplane . . . the first network interface card forming at least a portion of the first communication path coupling each of the plurality of web server processing cards with the public network." The Examiner relies on *Dellacona* for disclosure of the recited features. Accordingly, for reasons similar to those discussed above with regard to Claim 31, Applicant respectfully submits that *Dellacona* does not disclose each and every element as set forth in Applicant's Claim 1. Rather, *Dellacona* merely discloses a system that

includes bypass interface cards 24 for communicating information in disk storage devices 22 to and from server system 10. (Figure 4). Thus, *Dellacona* cannot be said to disclose, teach, or suggest "a first network interface card coupled with each of the plurality of web server processing cards and the midplane . . . the first network interface card forming at least a portion of the first communication path coupling each of the plurality of web server processing cards with the public network," as recited in Applicant's independent Claim 1.

As another example, neither *Dellacona* nor *Sistanizadeh* disclose, teach, or suggest that a portion of "the second communication path that couples the network interface card with the public network is entirely independent of a portion of the first communication path that couples the network interface card with the private network," as recited in Applicant's independent Claim 1. The Examiner acknowledges that *Dellacona* fails to disclose a private network and instead relies on *Sistanizadeh* for disclosure of the recited features. (Office Action, page 5). Specifically, the Examiner equates the LAN illustrated in Figures 1-3 of *Sistanizadeh* with Applicant's private network. As stated above, however, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Although *Sistanizadeh* discloses an "end-to-end architecture of a network that can support access to on-line services by either standalone or LAN based computers at customer premises" (Column 5, lines 29-32), the elements of the network architecture of *Sistanizadeh* are not arranged as required by Applicant's claims. To the contrary, *Sistanizadeh* discloses that the "Internet consists of Autonomous Systems (AS) which . . . are shown in FIG. 1 at 10, 12, and 14." (Column 1, lines 62-67). "Corporate Local Area Networks (LANs), such as those illustrated in 28 and 30, are connected through routers 32 and 34 and links shown as T1 lines 36 and 38." (Column 2, lines 14-17). Thus, the LANs disclosed in *Sistanizadeh* are directly connected to the Internet through routers 32 and 34 and T1 lines 36 and 38. (Figure 1). Therefore, the communication path from a first network interface card to the public network is not entirely independent of the communication path from the network interface card to the private network. Accordingly, *Sistanizadeh* cannot be said to disclose, teach, or suggest "the second communication path is entirely independent of the first communication path such that there is no physical connection

between the private network and the public network," as recited in Applicant's independent Claim 1.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Applicant's Claim 1.

Dependent Claims 2-29 depend upon independent Claim 1 and are not obvious over the proposed *Dellacona-Sistanizadeh* combination at least because they include the limitations of Claim 1, which Applicant has shown above to be allowable. Additionally, Applicant respectfully submits that the proposed *Dellacona-Sistanizadeh* combination does not disclose each and every feature as recited in Applicant's dependent claims.

As just one example, Claim 4 recites "the first network interface card is disposed along the first communication path and operable to route the data packets between the web server processing cards and the public network communication router." As another example, Claim 5 recites "a second network interface card disposed along the second communication path . . . [and] operable to route the processing request between one of the plurality of web server processing cards and the private network router." Claims 6-8 recite certain similar features and operations. The Examiner relies on *Dellacona* for the disclosure of the recited limitations. Accordingly, for reasons similar to those described above with regard to Claim 1, Applicant submits that the recited elements are completely absent from the teachings of *Dellacona*.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2-29.

The Office Action rejects Claims 32, 35-37, and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Dellacona* and in further view of U.S. Patent No. 6,144,638 issued to Obenhuber et al. ("*Obenhuber*"). Applicant respectfully traverses these rejections for the reasons stated below.

First, dependent Claims 32, 35-37, and 42 depend upon independent Claim 1 and are not obvious over the proposed *Dellacona-Obenhuber* combination at least because they include the limitations of Claim 31, which Applicant has shown above to be allowable.

Second, Applicant submits that one of ordinary skill in the art at the time of Applicant's invention would not have been motivated to combine the server information system of *Dellacona* with the corporate LANS of *Obenhuber*. Even where an invention is as

a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the claim combination. *ASC Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). In the Office Action, the Examiner acknowledges that *Dellacona* fails to disclose web server processing cards coupled with a private network communication router over a second communication path. (Office Action, page 12). The Examiner states, however, that *Dellacona* "suggested exploration of art and/or provided a reason to modify the data processing system with the private network communication router (Figure 2)." (Office Action, page 12). For reasons similar to those discussed above with regard to Claim 1, Applicant disagrees with the Examiner's characterization of Figure 2 of *Dellacona*. As discussed above, Figure 2 is merely an illustration of a preferred server configuration for the system disclosed in *Dellacona*. Further, *Dellacona* provides that the server configuration is designed to respond to the need to "eliminate the incomparability problems previously associated with performing diagnostics of an information server system." Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated at the time of Applicant's invention to combine the teachings of *Dellacona* with the teachings of *Obenhuber* to "include the private network feature since private network such as LAN would provide easy, cost-effective, and high-speed access to the Internet for corporations and private users (*Obenhuber*, column 1 lines 29-34)," as the Examiner suggests. To the contrary, the Examiner's speculation at to why "it would have been obvious" to make the proposed combination merely restates the objective of the system disclosed in *Obenhuber*. There is no disclosure in either *Dellacona* or *Obenhuber*, however, that provides the necessary suggestion or motivation for combining the server information system of *Dellacona* with the corporate LANs of *Obenhuber*. Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200 (Fed. Cir. 1991).

Third, Applicant respectfully submits that the proposed *Dellacona-Obenhuber* combination does not disclose each and every feature as recited in Applicant's dependent claims. As just one example, Claim 32 recites "each of the plurality of web server processing cards are coupled with a private network communication router over a second communication path, the private network communication router coupled with at least one private processing

system and operable to provide processing services upon receipt of a processing request from one of the plurality of web server processing cards." The Examiner relies on *Obenhuber* for disclosure of the recited features and operations. However, *Obenhuber* merely discloses hardware and software components needed for a network that includes each LAN or WAN 110-113 connected by a router 130-133 to a sub-backbone 140 or the main backbone 141 of the internetwork 100." (Column 3, lines 9-16). "A private user 160 can access the internetwork through an on-line service provider 170 or an internet work access provider 180." (Column 3, lines 16-18). Thus, the routers and communication paths disclosed in *Obenhuber* merely allow a user to access the Internet. Accordingly, Applicant respectfully submits that *Obenhuber* does not disclose, teach, or suggest "each of the plurality of web server processing cards are coupled with a private network communication router over a second communication path" or "the private network communication router coupled with at least one private processing system and operable to provide processing services upon receipt of a processing request from one of the plurality of web server processing cards," as recited in dependent Claim 32.

As another example, Claim 42 recites that "first and second power supplies are load balanced." The Examiner relies on *Dellacona* for disclosure of the recited features and operations. However, *Dellacona* merely provides that the circuitry of bypass interface cards 24 allows disk storage devices 22 to be taken on and off line when a bypass interface card fails. (Column 3, lines 45-59). Additionally, *Dellacona* discloses "[t]he fan and power supply components are hot swappable, so that once they are identified as failed and off line, they can readily be replaced, without requiring any down time for the server unit." (Column 7, lines 40-55). Thus, the cited portions of *Dellacona* merely discuss the interchangeability of bypass interface cards 24 and the power supplies such that each are hot swappable. Accordingly, *Dellacona* does not disclose that "the first and second power supplies are load balanced."

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 32, 35-37, and 42.

Conclusions

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant believes no fee is due, however; should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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